

REMARKS/ARGUMENTS

These remarks are submitted responsive to the office action dated July 9, 2004 (Office Action). As this response is timely filed within the 3-month shortened statutory period, no fee is believed due.

In paragraph 1 of the Office Action, claims 1, 5, 7-9 were objected to for minor informalities which have been corrected herein.

In paragraphs 2 and 3 of the Office Action, claims 1-12 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Published Application No. US 2002/0101858 to Stuart, et al. (Stuart).

In response, Applicants have enclosed declarations under 37 C.F.R. § 1.131 supporting the removal of Stuart as a reference. The declarations are accompanied by a copy of the Applicants' Confidential Invention Disclosure BOC8-2000-0003 (Disclosure) entitled "Multi tier ASP/Software Delivery for Wireless Devices." The Disclosure and declarations demonstrate proof of conception for the claimed subject matter of the Applicants' invention at least as early as January 18, 2000, which predates the effective date of Stuart of January 1, 2001.

The Disclosure is a completion of an International Business Machines Corporation (IBM) confidential disclosure form, which is a standardized IBM document utilized by the and submitted by the inventors upon conception of an invention. The document management system under which the IBM confidential disclosure form has been generated does not permit amendments to be made to the disclosure, once the disclosure has been completed. Any changes and/or additions are appended to an attachment to the IBM confidential disclosure form along with the date the

attachment was added. No such attachment accompanies the Disclosure, signifying that the Disclosure has not been amended since January 18, 2000.

The IBM confidential disclosure form provides all information necessary for outside legal counsel to prepare an appropriate patent application relative to the disclosed invention when used in conjunction with information known by one of skill in the art. The present Application, including each claim within the present Application, has been prepared based upon the Disclosure. Further, as noted in the enclosed Declarations, prior to submission of the Application to the U. S. Patent and Trademark Office (USPTO), the inventors review the Application to assure that the claims and material contained therein are fully supported by the Disclosure.

Applicants further exercised due diligence from prior to the effective date of Stuart until August 6, 2001, the filing date of the instant application. In regard to diligence, as set forth in the Declarations, once an IBM invention disclosure form is completed, the Disclosure is reviewed by an invention review board within IBM to determine whether to prepare an application based upon the submitted disclosure. Upon reaching a decision to prepare an application, outside counsel is selected to prepare the application, instructions in this regard along with the IBM invention disclosure form are conveyed to the outside counsel. The outside counsel prepares a draft of the Application that is iteratively reviewed by each inventor until such time that the inventors are satisfied that the Application sufficiently details the inventive concepts detailed in the Disclosure, at which time the Application is expeditiously filed with the USPTO.

As the Applicants conceived of the present invention before the effective date of Stuart, and exercised due diligence in constructively reducing the invention to practice between the date

U.S. Patent Appln. No. 09/923,506
Amendment Dated Oct. 12, 2004
Reply to Office Action of July 9, 2004
Docket No. BOC9-2001-0006 (241)

of the Disclosure until the filing date, as supported by the enclosed Declarations, Stuart should be withdrawn as a reference for purposes of 35 U.S.C. § 102(e), which action is respectfully requested. Withdrawal of Stuart as a reference should result in a withdrawal of the rejections with respect to claims 1-12.

Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. The Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

Date: 10/12/04



Gregory A. Nelson, Registration No. 30,577
Richard A. Hinson, Registration No. 47,652
Brian K. Buchheit, Registration No. 52,667
AKERMAN SENTERFITT
Customer No. 40987
Post Office Box 3188
West Palm Beach, FL 33402-3188
Telephone: (561) 653-5000